

REMARKS

Claims 1-9, 11-21, 23-29, and 31-43 are pending. Claims 42 and 43 are herewith canceled. Thus, with the entry of this amendment and for purposes of Appeal, claims 1-9, 11-21, 23-29, 31-41 will be active in this case. Applicants assert that entry of the above amendment is proper as it clarifies the status of the claims for Appeal.

I. STATUS OF CLAIMS 42 and 43

In paragraph 2, the Examiner has said that claims 42 and 43 are withdrawn from examination as they are considered to be independent and distinct from the invention originally claimed. In response, applicants herewith cancel claims 42 and 43 and reserve the right to pursue subject matter covered by claims 42 and 43 in a divisional application.

II. PRIORITY

In paragraph 8, the Examiner maintains that the claims, reciting a method of reducing kidney retention of a protein conjugate, are not entitled to the benefit of the filing date of USSN 08/407,899, March 21, 1995, for the asserted reason that the species "antibodies" disclosed in USSN 08/407,899 does not support the genus "protein conjugate," of the claims. Applicants incorporate by reference all previous arguments made in connection with this issue and assert that the disclosure of antibodies in the parent case would have shown the skilled artisan at the time of the invention that applicants were **in possession of the invention**. *Vas-Cath Inc. v. Mahurkar* 935 F.2d 1555, 19 USPQ 2d 1111 (Fed. Cir. 1991) (emphasis added).

III. REJECTIONS UNDER 35 USC §102 AND §103

The Examiner also has maintained the rejections of claims 1-8, 11-19, 23-28, 31-39 and 41 under 35 USC §102(b) and §103. In response, applicants incorporate by reference arguments presented in the previous responses.

IV. REJECTIONS UNDER 35 USC §112

Applicants acknowledge, with appreciation, the Examiner's withdrawal of the prior rejections of claims 19, 38 and 40 under 35 USC § 112.

VII. DOUBLE PATENTING REJECTION

The Examiner has maintained the provision rejection of claims 1-9, 11-21, 23-29 and 31-41 under the judicially created doctrine of obviousness-type double patenting over claims 38-47 of copending application No. 10/438,219. Because this rejection is provisional, applicants will not address this rejection in the forthcoming Appeal.

CONCLUSION

Applicants again respectfully request Examiner Helms to reconsider and grant the amended claims the benefit of the earliest priority date. Applicants also respectfully request Examiner Helms to withdraw all prior art rejections. A Notice of Allowance is eagerly awaited.

Please direct all correspondence to the undersigned attorney at the address indicated below.

Respectfully submitted,

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